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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/657,800 | 09/08/2003 | Eric C. Peters | A1992007DC2 | 1582 |

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| 26643 | 7590 | 10/05/2007 |
| PETER J. GORDON, PATENT COUNSEL AVID TECHNOLOGY, INC. ONE PARK WEST TEWKSBURY, MA 01876 | | |

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| EXAMINER | |
| FLETCHER, JAMES A | |

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| ART UNIT | PAPER NUMBER |
| 2621 | |

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| MAIL DATE | DELIVERY MODE |
| 10/05/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/657,800 | Applicant(s) PETERS ET AL. | |
| | Examiner James A. Fletcher | Art Unit 2621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>5/04, 8/04, 6/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, and 8 of U.S. Patent No. 5,930,445. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 4 and 8 of the '445 patent, which depend on claim 1, recite all the limitations of claim 1 in the instant application.

Regarding claims 1 and 9, the application recites "a random access computer readable medium for storing a plurality of sequences of digital images," which is not patentably distinct from the '445 patent's recitation of "a random access computer readable medium on which a plurality of sequences of digital images are stored."

Claims 1 and 9 of the application also recite "from one or more sources of frames captured for playback at a rate of 24 frames per second", which is not patentably distinct from the patent's recitation of "corresponding to the source and having a one-to-one correspondence with the playback rate of 24 frames per second."

Claims 1 and 9 of the application also recite "wherein each of the sequences of digital images is stored as a data file of a file system of a computer and has images having a one-to-one correspondence with the rate of 24 frames per second" which is also not patentably distinct from the above recitation. While the patent does not explicitly recite storing the images as data files of a file system, it is understood by those of ordinary skill in the art that images stored by a computer are routinely stored as data files.

Claims 1 and 9 of the application also recite "a nonlinear editing system" which is met by the patent's recitation of "nonlinear editing means."

Claims 1 and 9 of the application also recite "means for permitting a user to specify scenes from the sequences of digital images stored in the data files on the random access computer medium" which is met by the patent's recitation of "means, responsive to user input, for specifying a sequence of segments of said plurality of sequences of digital images store[d] on the random access computer readable medium."

Claims 1 and 9 of the application also recite "wherein a scene is defined by a reference to a data file storing a selected one of the sequences of digital images and by frame points designated in the selected sequence of digital image," which is met by the

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patent's recitation of "wherein a start location and a stop location of each segment in its corresponding sequence of digital images." Again, although the patent does not explicitly recite storing the images as data files of a file system, it is understood by those of ordinary skill in the art that images stored by a computer are routinely stored as data files.

Claims 1 and 9 of the application also recite "wherein the frame points may be designated at any frame boundary using a metric based on the playback rate of 24 frames per second," which is met by the patent's recitation of a start location and a stop location of each segment in its corresponding sequence of digital images may be at any frame boundary and are temporal resolution corresponding to the playback rate of 24 frames per second."

Claim 1 of the application further recites "means for permitting a user to specify a sequence of one or more specified scenes," which is met by the patent's recitation of "means for generating a representation of the program from the sequence of segments of the sequences of digital images."

Claim 1 of the application further recites "selection means for enabling a user to select one of a plurality of output frame rates." Although the patent does not explicitly disclose a selection means, it does disclose in claim 4 (which depends on claim 1 and inherently contains all the limitations thereof) "means for generating redundant video fields within the television signal so that the television signal can be displayed at a frame rate of 29.97 frames per second, and in claim 8 (which indirectly also depends on claim 1) "the representation of the program...[is] displayed at a frame rate of 24 frames

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per second." Since the claimed apparatus of the patent can have outputs of either 24 frames per second or 29.97 frames per second, it is obvious that a means for selecting the output rate would be available in the patented apparatus.

Claim 9 of the application recites "means for updating the stored information with the designated frame points of each specified scene in response to specification of the scenes from the sequence of digital images," which is met by the patent's claim 10 (which depends on claim 1) which recites "means for updating the bin with the start location and the stop location of each segment in response to the specifying of the sequence of segments of the sequence of digital images." As is understood by those of skill in the art, the start and stop locations of the sequence are likely to be frame points.

Claims 1 and 9 of the application further recites "means for producing a representation of an audiovisual work from the specified sequence" which is met by the patent's recitation of "means for generating a representation of the program from the sequence of segments of the sequences of digital images."


Finally, claims 1 and 9 of the application recites "in accordance with the selected one of the plurality of output frame rates. Both claims 4 and 8 of the patent recite a generated representation of the program in accordance with specified frame rates. Although the patent does not explicitly disclose a selecting means, since the output can be one of a plurality of frame rates, it is obvious to one of ordinary skill in the art that a selecting device would be available in the patented apparatus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Fletcher whose telephone number is (571) 272-7377. The examiner can normally be reached on 7:45-5:45 M-Th, first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JAF
15 September 2007


JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600